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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,303	11/25/2003	Rajesh Pendekanti	ETH 5102 (16032)	7062
23389	7590	09/02/2005	EXAMINER	
SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530			GIBSON, ROY DEAN	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 09/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/721,303

Applicant(s)

PENDEKANTI ET AL.

Examiner

Roy D. Gibson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7, 28 and 29 is/are allowed.
- 6) ☒ Claim(s) 8, 11-14, 16-23 and 25-27 is/are rejected.
- 7) ☒ Claim(s) 9, 10, 15 and 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/30/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear from the recitation in the claims if the contacts are mechanical or electrical or perhaps both. Clarification is required. The examiner has assumed the first, second, third and forth contacts are electrical contacts.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Yates et al. (5,688,270). Yates et al. disclose an ablation device, comprising:

- a first jaw (Figure 23, # 535) including a first electrode (552);
- a second jaw (532) having a proximal end and including a second electrode (528), the second jaw operatively associated with the first jaw and opposing the first jaw;

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an actuation mechanism (Figure 1 with 12, 14 and 59) releasably coupled to the proximal end of the second jaw;

a first actuation member (12) responsive to the actuation mechanism, and extending from the proximal end of the second jaw for causing a clamping movement of the first and second jaws; and

an electrical supply line (Figure 5, # 59c) responsive to the actuation mechanism (59), and extending from the proximal end of the second jaw for electrically energizing the first and second electrodes (col. 5, line 21-col. 7, line 62 and col. 10, line 40-col. 11, line 10).

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 21-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Mollenauer (6,821,273). Mollenauer discloses a combined dissecting, cauterizing and stapling device with a stapler head comprising all elements claimed (Figures 1 and 10-12, col. 2, lines 28-col. 3, line 65 and col. 5, lines 19-45 and col. 7, line 62-col. 8, line 10).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 11-14, 16-17 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mollenauer.

As to claims 8, Mollenauer discloses an ablation device (capable of ablation because a tissue temperature of 100 degrees C is disclosed) comprising a first jaw (Figure 16, # 2) including a first electrode (91);

a second jaw (3) having a proximal end and including a second electrode (90), the second jaw operatively associated with the first jaw and opposing the first jaw;

an actuation mechanism (Figure 1, #s 5 and 10 and a switch for the electrical current) releasably coupled to the proximal end of the second jaw;

a first actuation member (5) responsive to the actuation mechanism, and extending from the proximal end of the second jaw for causing a clamping movement of the first and second jaws; and

an electrical supply line responsive to the actuation mechanism (switch), and extending from the proximal end of the second jaw for electrically energizing the first and second electrodes (Figures 1 and 10-12, col. 2, lines 28-col. 3, line 65 and col. 5, lines 19-45 and col. 7, line 62-col. 8, line 10).

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As to claims 11-14 and 16-17, Mollenauer discloses a clamping ablation head comprising all elements as claimed (Figures 1 and 10-12, col. 2, lines 28-col. 3, line 65 and col. 5, lines 19-45 and col. 7, line 62-col. 8, line 10) with the exception of an electrode holder that is removably receivable by one of the first or second jaws. However, the examiner maintains this would have been an obvious design choice as supported by case law: the separation of elements, where removability would be desirable, is a design consideration within the skill of the art. In re Dulberg, 283 F.2d 522, 129 USPQ 348 (CCPA 1961).

As to claims 25-27, Mollenauer discloses a combined stapler and ablation head (capable of ablation because a tissue temperature of 100 degrees C is disclosed) comprising all elements as claimed (Figures 1 and 10-12, col. 2, lines 28-col. 3, line 65 and col. 5, lines 19-45 and col. 7, line 62-col. 8, line 10) with the exception of an electrode holder that is removably receivable by one of the first or second jaws. However, the examiner maintains this would have been an obvious design choice as supported by case law: the separation of elements, where removability would be desirable, is a design consideration within the skill of the art. In re Dulberg, 283 F.2d 522, 129 USPQ 348 (CCPA 1961). Further to claim 27, the electrode holder (Figure 11, # part of # 3) is provided as an overlay of the second jaw (col. 7, lines 8-61).

***Allowable Subject Matter***

Claims 1-7, 28 and 29 are allowed.

Claims 9-10, 15 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 18-20 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Baily (US 2005/0021026) discloses a device for grasping and Rf sealing of tissue; and Hooven et al. (6,517,536) disclose a transmural ablation device (see Figure 34-35 and col. 9, line 25-col. 10, line 67).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roy D. Gibson whose telephone number is 571-272-4767. The examiner can normally be reached on M-F, 7:30 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Roy D. Gibson  
Primary Examiner  
Art Unit 3739

August 31, 2005